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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|---------------------|------------------|
| 09/892,490 | 06/28/2001 | Robert Everett Parkhill | 77666-10/jlo | 3152 |
| 7380 | 7590 | 01/25/2006 | EXAMINER | |
| SMART & BIGGAR/FETHERSTONHAUGH & CO. P.O. BOX 2999, STATION D 900-55 METCALFE STREET OTTAWA, ON K1P5Y6 CANADA | | | PICH, PONNOREAY | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2135 | | |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/892,490 | PARKHILL ET AL. |
| | Examiner | Art Unit |
| | Ponnoreay Pich | 2135 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 October 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2 and 14-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 12 and 14-21 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-12 and 14-21 are pending. Any objections or rejections not repeated below for record are withdrawn due to applicant's amendments and/or arguments.

Response to Arguments

Applicant argues that the term "assertion" is a well-known and understood term in the art of security and cryptography systems. Applicant provided three references which either defines the term or uses the term. The examiner notes that applicant's effective filing date is 6/28/2001. All three references provided by applicant are dated well after 2001. The examiner respectfully submits that as the technology in an art progresses, the meaning of terms used in the art usually evolves and new terms appear in the art which may not have been used before. The examiner submits that the references provided by applicant does not show that the term "assertion" would have been well known and understood by one of ordinary skill in the art at the time applicant's invention was made.

The rest of applicant's argument have also been considered, but are moot in view of new rejections presented below. Please also note the new 101 rejections which are the result of new guidelines issued by the Office for examiners to follow in considering claims for 101. According to the new guidelines, a method being "computer-implemented" is immaterial to making a determination to whether the subject matter is patent-eligible. Likewise, for an apparatus, system, or machine to be a physical object, at least one recited element must be hardware. If all elements would have been reasonably interpreted in light of the disclosure by one of ordinary skill as

software alone, the claim is directed to software per se and is not statutory. Any inconvenience is regretted.

Claim Objections

Claim 14 is objected to because of the following informalities: The comma after "time" in line 9 should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 14-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claims 1, 3, 7, 8, 11, and 13-15 use the term "assertion". Neither applicant's specification nor the claims themselves define what applicant's definition of an assertion is and it does not appear to be a well-known and understood term in the art at the time applicant's invention was made. It is also not clear what is an "assertion between a name and a public key".
2. Claim 15 recites "assertion validity". Like assertion, it is unclear what assertion validity is.
3. Any claims not specifically addressed are rejected by virtue of dependency.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 and 15-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1:

Claim 1 is directed towards a computer-implemented method of providing assertions. In following new Office guidelines in determining whether or not the claimed computer related invention is statutory or not, the examiner respectfully notes that it is not clear that a concrete, useful, and tangible result is recited in claim 1. The method is directed towards providing assertions, but it is unclear what practical application just providing assertion would yield. The examiner notes that the 101 rejection can be overcome if applicant recites a practical application for the method and recites using the assertion for something.

Claim 2:

Claim 2 also does not recite a practical application and use for the assertion and is not statutory.

Claim 3:

Claim 3 recites a system comprising a repository, a purchase component, a request component, and a revocation component. Applicant's specification discloses that a repository is a database, which is software and a purchase component, a request component, and a revocation component as being implemented via software. Because claim 3 appears to be directed to software per se, claim 3 is not statutory. According to

the new 101 guidelines, applicant would have to recite at least one hardware component to overcome the 101 rejection.

Claims 4-6:

Claims 4-6 further define the software system of claim 3, but also do not recite any hardware, thus are not statutory. If applicant recites a hardware component for the system of claim 3, claims 4-6 would become statutory.

Claim 7:

The method of claim 7 does not recite a concrete, useful, and tangible result and thus is not statutory.

Claims 8-10:

Claims 8-10 also do not recite a concrete, useful, and tangible result and are not statutory.

Claim 11:

The method of claim 11 does not recite a concrete, useful, and tangible result and thus is not statutory.

Claim 12:

Claim 12 also does not recite a concrete, useful, and tangible result and is not statutory.

Claim 15:

Claim 15 is directed towards a system comprising software means, thus is directed towards software per se and is not statutory. According to the new 101 guidelines, the system being computer implemented is immaterial to determining

whether or not the system is statutory and for it to be statutory. The claim must recite at least one hardware component to be statutory.

Claim 16:

Claim 16 also is directed towards software per se as the means for monitoring is disclosed in the specification as a software means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 17-18, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al (US 5,982,898) in view of Lopez et al (US 2002/0103762).

Claim 1:

Hsu discloses the limitation of:

1. Upon request, generating an assertion between a name and a public key, the assertion having a lifetime (col 4, line 56-col 5, line 7).
2. Upon request, revoking an assertion (col 3, lines 19-26).

Hsu does not disclose:

1. Selling a pool of unallocated time.
2. Subtracting the lifetime from the unallocated time.

3. Adding any remaining lifetime to the unallocated time.

However, Lopez implicitly discloses selling a pool of unallocated time (p4, paragraph 35, lines 19-24). Lopez discloses subtracting the lifetime from the unallocated time (p4, paragraphs 36 and 38). Lopez discloses adding any remaining lifetime to the unallocated time (p3, paragraph 32, lines 1-10).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art, from Lopez's teachings, to modify Hsu's invention according to the limitations recited in claim 1. One of ordinary skill would have been motivated to do so because Lopez's teachings of refunding unused time would allow the customers of the certificate authorities disclosed by Hsu to not have to worry about wasting money if a certificate they paid for becomes compromised and they have to cancel the certificate before the time the certificate would naturally expire.

Claim 2:

Lopez further discloses the further step of eroding unallocated time over time (p5, paragraphs 42-43).

Claim 17:

Claim 17 is directed towards a computer readable medium having instructions stored thereon for execution on processing platform to execute the method of claim 1 and is rejected for the reasons set forth in claim 1.

Claim 18:

Claim 18 is directed towards a computer readable medium having instructions stored thereon for execution on processing platform to execute the method of claim 2 and is rejected for the reasons set forth in claim 2.

Claim 11:

Hsu implicitly discloses the limitation of identifying an assertion to be revoked, the assertion having a remaining lifetime (col 3, lines 19-26). In the cited passage, Hsu discloses that an assertion is revoked before its natural lifetime is reached due to it becoming compromised. This implies having to identify the assertion.

Hsu does not disclose the limitations of:

1. Maintaining an unallocated time, the unallocated time being time available for assertions.
2. Adding the remaining lifetime to the unallocated time.

However, Lopez discloses maintaining an unallocated time, the unallocated time being available of services (p4, paragraph 35, lines 19-24) and adding the remaining lifetime to the unallocated time (p3, paragraph 32, lines 1-10).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Hsu's invention using Lopez's teachings according to the limitations recited in claim 11. One of ordinary skill would have been motivated to combine Hsu and Lopez's teachings for the same reasons given in claim 1.

Claim 12:

Hsu further discloses wherein the assertion is a public key certificate (col 2, lines 12-32).

Claims 3-5 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez et al (US 2002/0103762) in view of Hsu et al (US 5,982,898).

Claim 3:

Lopez discloses the limitations of:

1. A repository containing unallocated time, the unallocated time indicating an amount of time available for a service (Fig 4, items 50).
2. A request component adapted to deduct the requested lifetime from the unallocated time (p4, paragraph 38).
3. A revocation component adapted to add the remaining lifetime to the unallocated time (p4, paragraph 40, lines 14-19).

Lopez does not explicitly disclose:

1. The service being assertions.
2. A purchase component adapted to add a requested bulk lifetime to the unallocated time.
3. The deduction of the requested lifetime from the unallocated time being done upon generation of an assertion.

4. Revocation of an assertion.

However, Hsu discloses a service being assertions (Fig 3). Hsu discloses generation of an assertion with a requested lifetime (col 4, line 56-col 5, line 7). Hsu discloses revocation of the assertion having a requested lifetime (col 3, lines 19-26).

In light of the above, at the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to combine Lopez and Hsu's teachings such that the unallocated time indicated an amount of time available for assertions; upon generation of an assertion with a requested lifetime, deduct the requested lifetime from the unallocated time; and upon revocation of the assertion having a remaining lifetime, add the remaining lifetime to the unallocated time. One of ordinary skill would have been motivated to combine Lopez and Hsu's teachings for the same reasons given in claim 1.

Hsu also does not explicitly disclose a purchase component adapted to add a requested bulk lifetime to the unallocated time. However, the examiner asserts that this was a well known feature at the time applicant's invention was made. For example, when a calling card is low on minutes, a user is able to buy more minutes to add to the card to increase the number of minutes available for the account associated with the card. This reads on a purchase component adapted to add a requested bulk lifetime to the unallocated time.

It would have also been obvious to one of ordinary skill in the art in light of the above common knowledge in the art to further modify Lopez and Hsu's combination

invention to include a purchase component adapted to add a requested bulk lifetime to the unallocated time. One of ordinary skill would have been motivated to do so because by allowing more time to be added to the unallocated time, it would allow a user of Lopez and Hsu's combination invention to continually use the same account number for their prepaid service instead of having to get another account when the unallocated time runs out.

Claim 4:

Hsu further discloses wherein the assertion is a public key certificate (col 2, lines 12-32).

Claim 5:

Lopez and Hsu does not explicitly disclose the limitations of:

1. Monitor when the unallocated time falls below a threshold.
2. Notify a user associated with the unallocated time if the unallocated time falls below the threshold.

However, the examiner asserts that these limitations were well known in the art at the time applicant's invention was made. Usually when a calling card starts running low on minutes, the user is alerted that they only have a certain amount of minutes available. This reads on the above limitations.

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify Lopez's invention according to the limitations recited in claim 5. One of ordinary skill would have been motivated to do so as it would

give a user more time to purchase additional time credit for the unallocated time, thus preventing the account from accidentally running out of time in the middle of active use.

Claim 14:

Lopez discloses the limitations of:

1. Generating an entry in a repository, the entry including an unallocated time (p4, paragraph 35, lines 19-24 and paragraph 38).
2. Receiving a request for a service and a requested lifetime (p4, paragraph 35, lines 11-24).
3. Deducting the requested lifetime from the unallocated time, in the event that a request for a service is received (p4, paragraph 35, lines 11-24 and paragraph 38).
4. Adding the remaining lifetime to the unallocated time, in the event that the service is no longer needed (p4, paragraph 40, lines 14-19).

Lopez does not disclose:

1. Receiving a request for a purchase of bulk lifetime.
2. Adding the bulk lifetime to the unallocated time in the event that a request for a purchase of a bulk lifetime is received.
3. Receiving a request for an assertion and a requested lifetime, the assertion being between a name and a public key.
4. The service is an assertion.

5. Receiving an identification of an assertion to be revoked, the assertion having a remaining lifetime.

However, the examiner asserts that receiving a request for a purchase of bulk lifetime and adding the bulk lifetime to the unallocated time in the event that a request for a purchase of a bulk lifetime is received was well known at the time applicant's invention was made. For example, when a calling card is low on minutes, a user is able to buy more minutes to add to the card to increase the number of minutes available for the account associated with the card.

It would have also been obvious to one of ordinary skill in the art, in light of the above, to modify Lopez's invention to allow the addition of a bulk lifetime to the unallocated time in the event a request for a purchase of a bulk lifetime is received. One of ordinary skill would have been motivated to do so because by allowing more time to be added to the unallocated time, it would allow a user to continually use the same account number for their prepaid service instead of having to get another account when the unallocated time runs out.

Further, Hsu discloses receiving a request for an assertion and a requested lifetime, the assertion being between a name and a public key (col 4, line 56-col 5, line 7). Hsu discloses the service is an assertion (col 4, line 56-col 5, line 7). Hsu implicitly discloses receiving an identification of an assertion to be revoked, the assertion having a remaining lifetime (col 3, lines 19-26).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to combine the above teachings according to the limitations recited in claim 14. One of ordinary skill would have been motivated to combine Lopez and Hsu's teachings for the same reasons given in claim 1.

Claim 15:

Lopez discloses the limitations of:

1. Means for allocating a pool of unallocated time available for a service (p4, paragraph 35, lines 19-24).
2. Means for processing a request for a service, the service having a lifetime, the means for processing the request subtracting the lifetime from the unallocated time (p4, paragraphs 35, 36, and 38).
3. Means for processing a revocation of an existing service by determining any remaining lifetime of the existing service and adding at least a portion of the remaining lifetime of the service to the unallocated time (p4, paragraph 40, lines 14-19).

Lopez does not disclose the service is assertion validity and the assertion is between a name and a public key. However, Hsu discloses the service is assertion validity (p2, lines 12-37) and Hsu discloses assertion between a name and a public key having a lifetime which can be revoked (col 3, lines 16-26).

In light of the above, it would have been obvious to one of ordinary skill to combine Lopez and Hsu's teachings according to the limitations recited in claim 15.

One of ordinary skill would have been motivated to combine Hsu and Lopez's teachings for the same reasons given in claim 1.

Claim 16:

Claim 16 recites limitations substantially similar to what is recited in claim 5 and is rejected for the same reasons given in claim 5.

Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez et al (US 2002/0103762) in view of Hsu et al (US 5,982,898) and further in view of Stahl et al (US 5,138,650).

Claim 5:

Lopez and Hsu does not explicitly disclose the limitations of:

1. Monitor when the unallocated time falls below a threshold.
2. Notify a user associated with the unallocated time if the unallocated time falls below the threshold.

However, Stahl discloses the limitations of "monitor when the unallocated time falls below a threshold and notify a user associated with the unallocated time if the unallocated time falls below the threshold" (col 7, lines 12-20). At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify Lopez and Hsu's combination invention according to the limitations recited in claim 5 using Stahl's teachings. One of ordinary skill would have been

motivated to do so because Stahl discloses that his teachings would give the user additional time to purchase more credit (col 7, lines 12-15). In the case of Lopez and Hsu's combination invention, the credit is in the form of time.

Claim 16:

Claim 16 recites limitations substantially similar to what is recited in claim 5 and is rejected for the same reasons given in claim 5.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez et al (US 2002/0103762) in view of Hsu et al (US 5,982,898) and further in view of Anvekar et al (US 2002/0069188).

Claim 6:

Lopez and Hsu do not explicitly disclose wherein the request component determines whether the requested lifetime is greater than the unallocated time, and if the requested lifetime is greater than the unallocated time, presents the user with a set of options for remedying the insufficiency of the unallocated time.

However, Anvekar discloses monitoring the total value of an account and whether the account has sufficient value before allowing service to begin (p3, paragraph 28, lines 1-3). Anvekar further discloses if the account had an insufficient value, alerting the user to this and presenting the user with a set of options for remedying the insufficiency of the account value (p3, paragraph 31, lines 1-5).

From Anvekar's teachings, it would have been obvious to one of ordinary skill in the art to further modify Lopez and Hsu's combination invention such that the request component determines whether the requested lifetime is greater than the unallocated time, and if the requested lifetime is greater than the unallocated time, presents the user with a set of options for remedying the insufficiency of the unallocated time. One of ordinary skill would have been motivated to do so because it would prevent a user from using more time than they have paid for. Note that Anvekar discloses that the delivery of any service desired by a customer may benefit from his teachings (p2, paragraph 21, lines 1-4), i.e. his teachings can be useful in any type of service system. The examiner asserts that providing/managing assertions is a type of service.

Claims 7-10 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al (US 5,982,898) in view of Lopez et al (US 2002/0103762) and further in view of Anvekar et al (US 2002/0069188).

Claim 7:

Hsu discloses the limitation accepting a request for an assertion and a requested lifetime (col 4, line 56-col 5, line 7).

Hsu does not explicitly disclose:

1. Maintaining an unallocated time, the unallocated time being available for assertions.

2. Determining whether the unallocated time is greater than or equal to the requested lifetime.
3. Upon determining that the unallocated time is greater than or equal to the requested lifetime, deducting the requested lifetime from the unallocated time.

However Lopez discloses maintaining an unallocated time, the unallocated time being available for services (p4, paragraph 35, lines 19-24). Lopez discloses deducting the requested lifetime from the unallocated time (p4, paragraphs 36 and 38). At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to incorporate Lopez's teachings within Hsu's invention to maintain an unallocated time, the unallocated time being available for the service of assertions. One of ordinary skill would have been motivated to combine Hsu and Lopez's teachings for the same reasons given in claim 1.

Further, Anvekar discloses monitoring the total value of an account and whether the account has sufficient value before allowing service to begin (p3, paragraph 28, lines 1-3). From Anvekar's teachings, it would have been obvious to one of ordinary skill in the art to further modify Hsu and Lopez's combination invention such that it determines whether the unallocated time is greater than or equal to the requested lifetime and upon determining that the unallocated time is greater than or equal to the requested lifetime, deducting the requested lifetime from the unallocated time. One of ordinary skill would have been motivated incorporate Anvekar's teachings because it would prevent a user from using more time than they have paid for.

Claim 8:

Hsu further discloses forwarding the request for assertion to an entity responsible for generating assertions (col 2, lines 58-66).

Claim 9:

Hsu further discloses wherein the assertion is a public key certificate (col 2, lines 12-32).

Claim 10:

Lopez further discloses the further step of eroding unallocated time over time (p5, paragraphs 42-43).

Claims 19, 20, and 21:

Claims 19, 20, and 21 are directed towards a computer readable medium having instructions stored thereon for execution on processing platform to execute the method of claims 7, 9, and 10 respectively and are rejected for the reasons set forth in claims 7, 9, and 10 respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ponnoreay Pich
Examiner
Art Unit 2135

[Signature]
Primary Examiner
Art Unit 2135

PP